

REMARKS

Claims 2-12 and 14-24 stand rejected under 35 U.S.C. §112, second paragraph as being indefinite. Claims 1, 2, 14, 14, and 25 stand rejected under 35 U.S.C. §102(b) as being anticipated by Bezos, et al., (USP 6,029,141, filed June 26, 1997). Claims 3-10 and 15-22 stand rejected under 35 U.S.C. §103(a) as being anticipated by Bezos in view of Hartman, (USP 5,960,411, filed Sep. 12, 1997). Claims 11, 12, 23, and 24 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Bezos in view of Hartman, and in further view of Official Notice. Priority to co-pending applications has been denied because the pending claims lack proper support in the earlier filed application.

Applicants thank the Examiner for the courtesy of an in-person interview of Aug. 17th, 2005, in which certain claim limitations were discussed along with their corresponding support in the specification. In particular, the transaction ID was discussed and its corresponding functionality as claimed in the independent claims of the instant application. Mr. Wesinger and the undersigned submitted that the functionality of the transaction ID is supported throughout the specification, and in particular with regards to FIG. 3, item 317, where the transaction ID is shown being associated with a credit card number. However, the Examiner disagreed and no agreement was reached in the Interview.

The following Remarks will focus on the denial of the priority claim due to an alleged lack of support for the pending independent claims. The Remarks will first address the requirements expressed in the MPEP for making a *prima facie* case regarding a rejection due to an improper written description. The support for the transaction ID as claimed will then be identified in the specification.

The Examiner has failed to make a *prima facie* case for asserting a lack of support for the pending claims

Regarding claims asserting the benefit of an earliest filing date, the “examiner has the initial burden of presenting evidence or reasoning to explain why persons skilled in the art would not recognize in the original disclosure a description of the invention defined by the claims”. MPEP 2163 at 2100-183. Indeed, the Office action should “clearly communicate the findings, conclusions, and reasons which support them”. Id. at 2100-184.

The MPEP identifies a two-step process to satisfy this initial burden. First, the claim limitation at issue should be identified. Id.

Secondly, the Examiner should:

Establish a *prima facie* case by providing reasons why a person skilled in the art at the time the application was filed would not have recognized that the inventor was in possession of the invention as claimed in view of the disclosure of the application as filed. Id.

The Examiner must have a reasonable basis to challenge the adequacy of the written description, and the description as filed is “adequate, unless or until sufficient evidence or reasoning to the contrary has been presented by the examiner to rebut the presumption”. MPEP 2163.04. The initial burden of presenting evidence regarding the written description requires the Examiner to establish by a “preponderance of evidence why a person skilled in the art would not recognize in an applicant’s disclosure a description of the invention defined by the claims”. Id.

Thus, the MPEP requires that in a proper statement of rejection, the Examiner must set forth “express findings of fact which support the lack of written description conclusion”. MPEP 2163.05 I. These findings should:

(A) Identify the claim limitation at issue; and

(B) Establish a *prima facie* case by providing reasons why a person skilled in the art at the time the application was filed would not have recognized that the inventor was in possession of the invention as claimed in view of the disclosure of the application as filed. Id.

Applicants respectfully submit that the Examiner has failed to make a *prima facie* case to support a lack of written description rejection. It is respectfully submitted that the Examiner has neither identified a particular claim limitation that is at issue, nor has the Examiner provided any reasons why a person skilled in the art would not recognize in the specification a description of the invention as presently claimed.

Indeed, the Examiner has failed to identify any reasoning whatsoever for the rejection. The entirety of the rejection regarding lack of support reads:

Applicants' claim to priority to co-pending applications (10/703,823), (09/952,985), (09/110,708) and (08/572,543) is denied because the invention claimed in the current application lacks proper support in these earlier filed applications. Accordingly, the examiner will use the filing date of the current application (March 30, 2004) as the earliest priority date of the current invention. Office action mailed Aug. 11, 2004, at page 2.

This rejection fails to identify which claim limitation or limitations are at issue. Furthermore, no reasoning is provided for the Examiner's basis for rejection. Indeed, the rejection fails to identify even what claim is at issue.

No "express findings of fact" are presented, and no discussion is present as to why one skilled in the art would fail to find adequate description of the claims as filed in the specification of the parent applications. Accordingly, it is respectfully submitted that the Examiner has failed to make a *prima facie* case for denying the current application the earliest priority date claimed. Applicants respectfully traverse this rejection, and requests that the denial of the earliest priority claim be withdrawn and the pending claims be reconsidered in light of the earliest priority date claimed.

Applicants note that it is difficult to respond to the Examiner's rejection when all that has been presented is two-sentence conclusion devoid of any evidence or factual analysis. If the Examiner is still of the belief that the earliest priority date claimed is not properly supported, then Applicants respectfully request a more thorough Office action that includes which particular claim limitations are at issue, along with a presentation from the Examiner of a proper *prima facie* case as to why one skilled in the art would not find support in the specification for the invention as presently claimed. With a more reasoned analysis in hand, Applicants will then be in a better position to respond with particularity to the Examiner's concerns.

The transaction ID as presently claimed is properly supported in the specification as filed

As mentioned in the Examiner's Interview Summary and related in the Applicants' summary above, the Examiner took issue with the transaction ID element of the presently pending independent claims. Applicants will now show how proper support is found in the specification for the transaction ID as presently claimed.

Independent claims 1, 13, and 25 of the presently pending claims recite, *inter alia*, a transaction ID being created in the process of a purchase transaction being performed on a web site. The transaction ID as claimed has purchase information associated therewith that is used to complete the transaction.

Applicants are claiming an earliest priority date of Dec. 14, 1995, corresponding to the filing date of the original parent application now issued as US patent 5,778,367. To ensure that no new matter is being entered in the presently pending claims, the following discussion will cite columns and rows of the '367 patent as issued.

Turning now to the '367 specification, a transaction ID is created when a user attempts to add content to the database:

In order to add an entry to the database, a user must login, during which the user chooses a password, or must have logged in during a previous visit to the site. When the user chooses to add a new entry to the database, a unique transaction ID is created for that entry, to be used throughout the life of the entry. (Col. 9, lines 23-26)

The user may then enter information on a form:

Once a transaction ID has been assigned, the user is then provided with an entry form 317 having fields corresponding to the various fields of a database entry as described previously. (Col. 9, lines 40-43)

The specification provides that during the entry process, a form is presented that corresponds to the fields of the entry:

The form may have one or more checkboxes 319 to indicate the desire to include with the entry one or more non-textual elements, such as a graphic image, etc. Also, if desired, different templates may be provided governing the appearance of the finished page, with the user selecting a desired template. (Col. 9, lines 43-49)

It is contemplated that the graphics may be uploaded:

Non-textual content may be obtained from the user in any of a number of different ways. For example, the user may transfer to the site a file containing the non-textual content using the File Transfer Protocol (FTP) with the same user ID and password as when the entry was added. (Col. 9, lines 50-54)

The user may also indicate how the entry is to be indexed by supplying desired keywords:

During the entry process, the user is prompted to enter keywords to facilitate later searching of the database and location of the entry. (Col. 9, lines 55-58)

Other information may be collected, such as credit card information as recited in the presently pending independent claims:

If the server site is based on a pay-for-service model, the form will also call for the user to enter a credit card number as the last piece of information. (Col. 9, line 65 – Col. 10, line 1)

In another embodiment disclosed in the '367 specification regarding the secure updating of entries, the specification contemplates that the transaction ID may be used as a user ID for authentication purposes, in particular during the process of updating of an entry.

The following excerpt in particular shows the transaction ID facilitating authentication of a user, and the retrieval of both the personal information and credit card information associated with the user. The user is then charged for the ability to post and update a web page.

After an entry has been made, it may be updated at any time by one able to provide the transaction ID assigned to the entry and the user password, i.e., by the user or one acting on behalf of the user. The update option may be entered directly, or the entry to be updated may first be viewed as the result of a search and the update screen button 315 then pressed. The user is then prompted to supply the correct transaction ID and password (page 321), failing which the user will not be allowed to update the entry.

If the transaction ID and password are correctly supplied, then the equivalent of a new entry form will be provided to the user with the current information pertaining to the entry already filled in. The user may then modify the entry. If a charge is made for updating the entry, preferably the credit card information from the earlier creation of the entry will have been stored in a highly secure fashion, avoiding the need to reenter the information. Both security and convenience are thereby enhanced. (Col. 10, lines 9-28)

Thus, the '367 specification clearly provides support for the creation of a transaction ID, and the association of credit card information with the transaction ID as presently claimed in the instant application. The specification also provides proper support for the transaction ID being used to facilitate the completion of a credit card transaction. In embodiments fully disclosed in the '367 specification, the transaction ID is shown facilitating the retrieval and automatic population of a form with elements

previously provided by the user, and the initiation of a credit card charge process if necessary.

Applicants respectfully submit that the above excerpts show the transaction ID element of the presently pending claims being more than adequately described in the specification of the '367 parent application as originally filed. The detailed description and associated figures therein provide a proper written description such that one skilled in the art would recognize the transaction ID is adequately supported as claimed.

Applicants respectfully requests that the denial of the earliest priority claim be withdrawn and the pending claims be accorded the earliest priority date claimed in light of these remarks.

The rejections based upon the Bezos and Hartman reference should be withdrawn as the present case is entitled to a filing date prior to the effective filing date of either reference

Turning now to the 35 U.S.C. §102(b) rejection using Bezos, and the 35 U.S.C. §103(a) rejections using Bezos and Hartman, it is respectfully submitted that these rejections should be withdrawn as Applicants believe that the present case is entitled to the earliest priority date claimed, rendering both references unavailable under either 35 U.S.C. §102(b) or 35 U.S.C. §103(a) as the effective filing date of both references is after the earliest priority date claimed in the instant case.

The Examiner has improperly taken Official Notice of facts

Applicants note that the Examiner relied upon Official Notice to reject claims 11, 12, 23, and 24. Per MPEP 2144.03, Applicants traverse the Examiner's assertion that the email functionality as recited in claims 11, 12, 23, and 24 is old and well known in the art.

It is not clear from the record whether the Examiner is relying upon personal knowledge, or whether the Examiner is attempting to take Official Notice of the fact that

it is old and well-known for a web site to identify users using an email address and the sending of a password to a user at their email address.

If the Examiner is attempting to take Official Notice of a fact, then the Examiner is required to point to evidence in the record to support such a finding.

Ordinarily, there must be some form of evidence in the record to support an assertion of common knowledge. See Lee, 277 F.3d at 1344-45, 61 USPQ2d at 1434-35 (Fed. Cir. 2002); Zurko, 258 F.3d at 1386, 59 USPQ2d at 1697 (holding that general conclusions concerning what is "basic knowledge" or "common sense" to one of ordinary skill in the art without specific factual findings and some concrete evidence in the record to support these findings will not support an obviousness rejection). MPEP 2144.03 B

The Examiner has admitted in the Office action that the prior art does not teach the limitations as claimed in claims 11, 12, 23, and 24, and has only asserted a general conclusion regarding what is alleged to be old and well-known in the art. The Examiner has cited to Col. 1, line 66 to Col. 2, line 16 of Hartman as evidence for motivation; however, the cited section of Hartman is merely a general recitation of security concerns in the Background section in the context of the need for encryption and is irrelevant to the claims at issue. Therefore, the Examiner has failed to provide any substantial factual basis for taking Official Notice of these facts.

If the Examiner is relying on personal knowledge, then Applicants respectfully request a statement putting forth the Examiner's specific reasoning for taking Official Notice.

If the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding. MPEP 2144.03 C

Applicant respectfully traverses the taking of Official Notice, and respectfully submits that such a finding is inconsistent with MPEP 2144.03.

Applicants request that the rejections be withdrawn, and that this application be allowed. If the Examiner has any questions regarding this application, the Examiner may telephone the undersigned attorney at 775-848-5624.

Respectfully submitted,

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Timothy A. Brisson
Reg. No.: 44,046

Sierra Patent Group, Ltd.
P.O. Box 6149
Stateline, NV 89449
(775) 586-9500
(775) 586-9550 Fax